

REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1-96 were pending in the application, of which Claims 1, 25, 49, and 73 are independent. In the Office Action dated June 16, 2004, Claims 1-96 were rejected under 35 U.S.C. § 112, §102(b), and §103(a), and the specification was objected to. Following this response, Claims 1-96 remain in this application. Applicant hereby addresses the Examiner's objects and rejections in turn.

I. **Objection to the Specification**

In the Office Action dated June 16, 2004, the Examiner objected to the specification because it contains embedded hyperlinks. The specification has been amended to either remove the hyperlinks or, to the best of Applicant's knowledge, to include text that does not either produce a hyperlink or does not produce a hyperlink to a commercial website. Applicants respectfully submit that the amendment overcomes this objection and adds no new matter.

II. **Rejection of the Claims Under 35 U.S.C. § 112, Second Paragraph**

In the Office Action, the Examiner rejected Claims 1-96 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. Applicant respectfully traverses this rejection.

The Patent Act requires that through the patent claims, an applicant must particularly point out and distinctly claim the subject matter which he regards as his invention. (See 35 U.S.C. § 112, ¶ 2; “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”) The test for whether a claim meets the definiteness requirement is “whether one skilled in the art would understand the bounds of the claim when read in light of the specification.” At least because the claims as originally filed are considered a part of the specification and because the Examiner is rejecting the original claims, the specification clearly contemplates the claimed invention. Furthermore, the claimed subject matter is clear and is fully disclosed in the specification, for example, at pages 8-19. Accordingly, Applicants respectfully request withdrawal of this rejection under 35 U.S.C. § 112, second paragraph.

Moreover, in the Office Action, the Examiner rejected Claims 1-96 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention. In this rejection, the Examiner stated that “the function of a transparent proxy server using a modified header was well-known in the art, see references of PTO-892.” Applicant respectfully traverses this rejection because citing alleged prior art to attempt to show that the claimed subject matter is “well-known” is improper for a rejection under 35 U.S.C. § 112, second paragraph. Again, the test is “whether one skilled in the art would understand the bounds of the claim when read in light of the specification.”, whether the claimed subject matter is allegedly well-known in view of alleged prior art.

III. Rejection of the Claims Under 35 U.S.C. § 102(e) Using Agassi

In the Office Action, the Examiner rejected Claims 1-96 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,441,843 ("Agassi"). Applicant respectfully traverses this rejection. Claims 1, 25, 49, and 73 have been amended, and Applicant respectfully submits that the amendment overcomes this rejection and adds no new matter.

Amended Claim 1 is patentably distinguishable over the cited art in that it recites, for example, "the proxy server modifying at least one reference to the remote server in the first unit of digital content to form a modified first unit of digital content by inserting a surrogate server hostname into the at least one reference and removing a remote server hostname from the at least one reference, wherein the surrogate server hostname is different from the remote server hostname." Amended Claims 25, 49, and 73 include similar recitations.

In contrast, *Agassi* at least does not disclose the aforementioned recitation. For example, *Agassi* merely discloses creating a relation between two systems. (See col. 6, lines 16-31.) In *Agassi*, a remote server hostname is not removed from at least one reference. Consequently, *Agassi* does not anticipate the claimed invention because *Agassi* at least does not disclose the aforementioned recitation of amended Claim 1. Amended Claims 25, 49, and 73 include similar recitations. Accordingly, independent Claims 1, 25, 49, and 73 patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claims 1, 25, 49, and 73.

Dependent Claims 2-24, 26-48, 50,72, and 74-96 are also allowable at least for the reasons above regarding independent Claims 1, 25, 49, and 73, and by virtue of their respective dependency upon independent Claims 1, 25, 49, and 73. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims -24, 26-48, 50,72, and 74-96.

IV. Rejection of the Claims Under 35 U.S.C. § 102(e) Using *Hunt*

In the Office Action, the Examiner rejected Claims 1-96 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,253,234 ("*Hunt*"). Applicant respectfully traverses this rejection.

Amended Claim 1 is patentably distinguishable over the cited art in that it recites, for example, "the proxy server modifying at least one reference to the remote server in the first unit of digital content to form a modified first unit of digital content by inserting a surrogate server hostname into the at least one reference and removing a remote server hostname from the at least one reference, wherein the surrogate server hostname is different from the remote server hostname." Amended Claims 25, 49, and 73 include similar recitations.

In contrast, *Hunt* at least does not disclose the aforementioned recitation. For example, *Hunt* merely discloses that "a proxy server redirects or reroutes a request from a specific host name or IP address or another browser...where the proxy server acts as a surrogate or a conduit...". (See col. 6, lines 17-22.) In *Hunt*, inserting a surrogate server hostname into the at least one reference and removing a remote server hostname from the at least one reference is not disclosed. Consequently, *Hunt* does

not anticipate the claimed invention because *Hunt* at least does not disclose the aforementioned recitation of amended Claim 1. Amended Claims 25, 49, and 73 include similar recitations. Accordingly, independent Claims 1, 25, 49, and 73 patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claims 1, 25, 49, and 73.

Dependent Claims 2-24, 26-48, 50,72, and 74-96 are also allowable at least for the reasons above regarding independent Claims 1, 25, 49, and 73, and by virtue of their respective dependency upon independent Claims 1, 25, 49, and 73. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims -24, 26-48, 50,72, and 74-96.

V. Rejection of the Claims Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 1-96 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,138,162 ("*Pistriotto*") in view of U.S. Patent No. 5,961,601 ("*Iyengar*"). Applicant respectfully traverses this rejection because combining *Pistriotto* with *Iyengar* would not have led to the claimed invention.

Amended Claim 1 is patentably distinguishable over the cited art in that it recites, for example, "the proxy server modifying at least one reference to the remote server in the first unit of digital content to form a modified first unit of digital content by inserting a surrogate server hostname into the at least one reference and removing a remote server hostname from the at least one reference, wherein the surrogate server hostname is different from the remote server hostname." Amended Claims 25, 49, and 73 include similar recitations.

Combining *Pistriotto* with *Iyengar* would not have led to the claimed invention because *Pistriotto* and *Iyengar*, either individually or in combination, at least do not disclose or suggest the aforementioned recitation of amended Claim 1. Amended Claims 25, 49, and 73 include similar recitations. Accordingly, independent Claims 1, 25, 49, and 73 patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claims 1, 25, 49, and 73.

Dependent Claims 2-24, 26-48, 50,72, and 74-96 are also allowable at least for the reasons above regarding independent Claims 1, 25, 49, and 73, and by virtue of their respective dependency upon independent Claims 1, 25, 49, and 73. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims -24, 26-48, 50,72, and 74-96.

VI. Conclusion

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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